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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,905	08/31/2001	Osamu Imaichi	1021.40599X00	8131

24956 7590 03/07/2006

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EXAMINER	
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ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,905	IMAICHI ET AL.	
	Examiner	Art Unit	
	Anh Ly	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination (RCE)

1. The request filed on 12/12/2005 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/942,905 is acceptable and a RCE has been established. An action on the RCE follows.

2. This Office Action is response to Applicants' Amendment filed on 12/12/2005.

3. Claims 1-23 are pending in this application.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 6 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. As in claims 1, 6 and 16, the clause "... generated from a previous search of a document database$_i$" was not described in the Specification.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2, 4, 6, and 9 are rejected under 35 U.S.C. 101 because the "means" is software, per se. Ii is not a hardware component of the search system.

Claim Objections

8. Claims 1, 6, 10, 11, 12, 13, 14, 15, 16, 21, 22, & 23 are objected to because of the following informalities: the subscript (i, j) in the document database and x_{ij} should be spell out or indicate clearly in the claim language, (That is, what is the meaning of i, j, and x). Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 6-9, 10-15,16-18 and 21-23, as the best understanding of the examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,454,105 issued to Hatakeyama et al. (hereinafter Hatakeyama).

With respect to claim 1, Hatakeyama teaches a document search system (fig. 5, a document search and method system for searching and retrieving full text of documents from a document database or databases: abstract, col. 1, lines 15-20 and col. 10, lines 8-40), comprising:

an associative server which is capable of instructing a document search by specifying a document database$_j$ to be searched next among a plurality of document databases based on a search result generated from a previous search of a document database$_i$ (the document search system or server consisting of a search function/unit is for searching or retrieving full of text of documents containing a particular character string or strings from document database or databases, a set of search results containing the search term(s) (search character strings) of the search processing performed in the past may be provided in correspondence to the search request sources: figs. 4, 5, abstract, col. 6, lines 8-67); and

an associative search recording table which records the number of times X_{ij} of searching said document database$_j$ based on the search result generated from the previous searches of said document database$_i$ (fig. 17 shown the number of times of searching full text of documents containing a particular character string or string from a document database or databases and the search result set is stored in the table: col. 17, lines 10-28; col. 1, lines 12-20; also see fig. 22, col. 19, lines 47-60).

With respect to claim 2, Hatakeyama teaches changing a showing order of document databases to be searched by using said associative search recording table (the ordering of database is displayed: col. 19, lines 47-60).

With respect to claim 3, Hatakeyama teaches wherein a differing said associative search recording table is stored for each user, and, by using said associative search recording table for each user, a showing order of document databases to be searched is changed according to a user (this a document search system for a plurality of users to perform the search and who might be enable to change the search such as condition, selecting of input database: col. 17, lines 40-55, col. 10, lines 50-55 and col. 1, lines 20-25).

With respect to claim 6, Hatakeyama teaches associative means which is capable of instructing a document search by specifying a document database$_j$ to be searched next among a plurality of document databases based on a search result generated from a previous search of a document database$_i$ (the document search system or server consisting of a search function/unit is for searching or retrieving full of text of documents containing a particular character string or strings from document database or databases, a set of search results containing the search term(s) (search character strings) of the search processing performed in the past may be provided in correspondence to the search request sources: figs. 4, 5, abstract, col. 6, lines 8-67);

search query constructing means for sending the search query analyzed by said search query analyzing means to the document database specified by the search client (the search requests are accumulated in the waiting queue: col. 3, lines 1-10);

means for sending a search result of said specified document database to said search client (sending the search result: col. 3, lines 5-10); and

associative search recording table storing means for storing an associative search recording table recording the number of times Xij of searching a document database j based on a search result of a document database i (fig. 17 shown the number of times of searching full text of documents containing a particular character string or string from a document database or databases and the search result set is stored in the table: col. 17, lines 10-28; col. 1, lines 12-20; also see fig. 22, col. 19, lines 47-60).

With respect to claim 7, Hatakeyama teaches showing order changing means for changing a showing order of document databases to be searched and to be shown to said search client by using data from said associative search recording table (the ordering of database is displayed: col. 19, lines 47-60).

With respect to claim 8, Hatakeyama teaches associative search recording table storing means which stores an associative search recording table for each user, and the showing order changing means for changing a showing order of document databases to be searched and to be shown to said search client according to a user by using said associative search recording table for each user (this a document search system for a plurality of users to perform the search and who might be enable to change the search such as condition, selecting of input database: col. 17, lines 40-55, col. 10, lines 50-55 and col. 1, lines 20-25).

With respect to claim 10, Hatakeyama teaches wherein for each document database of a plurality of select document databases, the associative search recording table has plural entries with differing entries for recording a respective number of times

xij of searching the document database j based on a search result of differing ones of document databases i, respectively (the set of search results based on the search requests from users inputted to the system accumulated in waiting queue: col. 2, lines 62-67 and col. 3, lines 1-10).

With respect to claim 11, Hatakeyama teaches storing, in the associative search recording table, a number of times xij of searching a document database j based on a search result of a keyword I (col. 4, lines 44-60 and col. 5, lines 4-32).

With respect to claim 12, Hatakeyama teaches wherein for each document database of a plurality of select document databases, the associative search recording table has plural entries with differing entries for recording a respective number of times xij of searching the document database j based on a search result of differing ones of document databases or keywords i, respectively (fig. 17 shown the number of times of searching full text of documents containing a particular character string or string from a document database or databases and the search result set is stored in the table: col. 17, lines 10-28; col. 1, lines 12-20; also see fig. 22, col. 19, lines 47-60 and col. 4, lines 44-60 and col. 5, lines 4-32).

With respect to claim 13, Hatayama teaches wherein for each document database of a plurality of select document databases, the associative search recording table has plural entries with differing entries for recording a respective number of times xij of searching the document database j based on a search result of differing ones of document databases i, respectively (fig. 17 shown the number of times of searching full text of documents containing a particular character string or string from a document

database or databases and the search result set is stored in the table: col. 17, lines 10-28; col. 1, lines 12-20; also see fig. 22, col. 19, lines 47-60 and col. 4, lines 44-60 and col. 5, lines 4-32).

With respect to claim 14, Hatakeyama teaches storing, in the associative search recording table, a number of times xij of searching a document database j based on a search result of a keyword I (col. 4, lines 44-60 and col. 5, lines 4-32).

With respect to claim 15, Hatakeyama teaches wherein for each document database of a plurality of select document databases, the associative search recording table has plural entries with differing entries for recording a respective number of times xij of searching the document database j based on a search result of differing ones of document databases or keywords i, respectively (fig. 17 shown the number of times of searching full text of documents containing a particular character string or string from a document database or databases and the search result set is stored in the table: col. 17, lines 10-28; col. 1, lines 12-20; also see fig. 22, col. 19, lines 47-60 and col. 4, lines 44-60 and col. 5, lines 4-32).

With respect to claim 16, Hatakeyama teaches a document search method (fig. 5, a document search and method system for searching and retrieving full text of documents from a document database or databases: abstract, col. 1, lines 15-20 and col. 10, lines 8-40) comprising the steps of:

instructing a document search by specifying a document database$_j$ to be searched next among a plurality of document databases based on a search result generated from a previous search of a document database$_i$ (the document search

system or server consisting of a search function/unit is for searching or retrieving full of text of documents containing a particular character string or strings from document database or databases, a set of search results containing the search term(s) (search character strings) of the search processing performed in the past may be provided in correspondence to the search request sources: figs. 4, 5, abstract, col. 6, lines 8-67);

storing an associative search recording table which records the number of times Xij of searching a document database j based on a search result of a document database I (fig. 17 shown the number of times of searching full text of documents containing a particular character string or string from a document database or databases and the search result set is stored in the table: col. 17, lines 10-28; col. 1, lines 12-20; also see fig. 22, col. 19, lines 47-60); and

using data from said associative search recording table to help specify a document database to be searched next among a plurality of document databases (col. 4, lines 8-22 and lines 44-60).

With respect to claim 17, Hatakeyama teaches changing a showing order of document databases to be searched by using data from said associative search recording table (the ordering of database is displayed: col. 19, lines 47-60).

With respect to claim 18, Hatakeyama teaches wherein a differing said associative search recording table is stored for each user, and, by using said associative search recording table for each user, a showing order of document databases to be searched is changed according to a user (this a document search system for a plurality of users to perform the search and who might be enable to change

the search such as condition, selecting of input database: col. 17, lines 40-55, col. 10, lines 50-55 and col. 1, lines 20-25).

Claim 21 is essentially the same as claim 10 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 10 hereinabove.

Claim 22 is essentially the same as claim 11 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 11 hereinabove.

Claim 23 is essentially the same as claim 12 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 12 hereinabove.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 4-5, 9 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,454,105 issued to Hatakeyama et al. (hereinafter Hatakeyama) in view of in view of US Patent No. 6,018,733 issued to Kirsch et al. (hereinafter Kirsch).

With respect to claims 4-5, Hatakeyama discloses a document search system as discussed in claim 1.

Hatakeyama teaches a document search system for allowing a plurality of users to searching a full-text of documents in a document database or databases and the set of search results are stored in a table based on the number of times of searching the document databases. Hatakeyama does not teach calculating a registration fee of each document database by using said associative search recording table.

However, Kirsch teaches fees are charged based on the calculation of the number of documents that are variously searched, reviewed and retrieved in preparation of a search report from a particular database (col. 1, lines 55-63 and col. 2, lines 10-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hatakeyama with the teachings of Kirsch by incorporating the use of a calculation of access fee for each of document database to be searched. The motivation being to perform effective

document searches over multiple, independent document databases, thereby, reducing the searching time required and to enhance the convenience for the user the document search to be searched and for evaluation properly the document database.

With respect to claim 9, Hatakeyama discloses a document search system as discussed in claim 6.

Hatakeyama teaches a document search system for allowing a plurality of users to searching a full-text of documents in a document database or databases and the set of search results are stored in a table based on the number of times of searching the document databases. Hatakeyama does not teach calculating a registration fee of each document database by using said associative search recording table.

However, Kirsch teaches fees are charged based on the calculation of the number of documents that are variously searched, reviewed and retrieved in preparation of a search report from a particular database (col. 1, lines 55-63 and col. 2, lines 10-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hatakeyama with the teachings of Kirsch by incorporating the use of a calculation of access fee for each of document database to be searched. The motivation being to perform effective document searches over multiple, independent document databases, thereby, reducing the searching time required and to enhance the convenience for the user the document search to be searched and for evaluation properly the document database.

With respect to claims 19-20, Hatakeyama discloses a document search method as discussed in claim 16.

Hatakeyama teaches a document search system for allowing a plurality of users to searching a full-text of documents in a document database or databases and the set of search results are stored in a table based on the number of times of searching the document databases. Hatakeyama does not teach calculating a registration fee of each document database by using said associative search recording table.

However, Kirsch teaches fees are charged based on the calculation of the number of documents that are variously searched, reviewed and retrieved in preparation of a search report from a particular database (col. 1, lines 55-63 and col. 2, lines 10-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hatakeyama with the teachings of Kirsch by incorporating the use of a calculation of access fee for each of document database to be searched. The motivation being to perform effective document searches over multiple, independent document databases, thereby, reducing the searching time required and to enhance the convenience for the user the document search to be searched and for evaluation properly the document database.

Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV **or fax to (571) 273-4039**. The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or **Primary Examiner Jean Corrielus (571) 272-4032.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://pair-direct.uspto.gov**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: Central Fax Center **(571) 273-8300**

ANH LY
FEB. 24th, 2006